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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,608	05/14/2001	Don F. Purpura	36.P317	6709
5514	7590	11/19/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			ALEXANDER, JESSE NELSON	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2666

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,608

Applicant(s)

PURPURA, DON F.

Examiner

Jesse N. Alexander

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/23/02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-15 is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 16, 17, 20 is/are rejected.
- 7) ☒ Claim(s) 6-8, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/27/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/14/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claims 2-9 are objected to because of the following informalities: the preamble "An interface" should be replaced with --The interface--. Appropriate correction is required.
3. Claims 11-15 are objected to because of the following informalities: the preamble "A method" should be replaced with --The method--. Appropriate correction is required.

4. Claims 17-19 are objected to because of the following informalities: the preamble "A device" should be replaced with --The device--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 9, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Challener et al. (US 6,754,826 B1).

Regarding claims 1-5, 9, 16 and 17, applicant's admitted prior art in fig. 2 discloses an interface device for interfacing between a networkable device and a network, comprising: a hub with plural ports (**fig. 2, element 14**) and constructed to repeat network transmissions received on one port to all other ports, said plural ports including a first port connectable to the network (**element 11**), a second port connectable the networkable device (**printer 10**); a third port connectable to a circuit board having network functionality (**PORT-C connected to element 15, circuit board with extended functionality**);

Applicant's admitted prior art teaches further an interface device wherein the networkable device comprises a printer (**fig. 2, element 10**), and wherein the extended functionality is functionality for secure printing in **page 3, line 29 to page 4, line 1**.

Applicant's admitted prior art teaches further an interface device wherein said control functionality provides the control signal based on the extended functionality of said circuit board (**in fig. 2 circuit board accesses or controls the printer via connection shown between PORT-C and PORT-B, this interface.**)

Applicant's admitted prior art fails to teach an isolation switch controllable operable to isolate the first port from network transmissions repeated by the hub.

However, Challener et al. teaches the concept of a network isolation switch in **figure 1, element 32** capable to isolate the client's network transmissions repeated by the hub **20, fig. 1 (see col. 3, lines 9-13)**, and the concept of a service processor **24, fig. 1**, that controls the switch.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify applicant's admitted prior art by placing the Challener et al. network isolation switch inside the interface device's hub between the network and **PORT-A**, and by adding the service processor and attendant control lines to the board having **EXTENDED FUNCTIONALITY 15, fig. 1**, applicant's admitted prior art. Said switch would have been capable to isolate network transmissions repeated in the hub from PORT-C and PORT-B and to accept a control signal for operation of the isolation switch from circuit board 15 via PORT-C. The motivation to combine and modify is to

prevent unauthorized access to the client device as taught by Challener et al. in **col. 2, lines 7-11**.

Regarding claim 20, applicant's admitted prior art in **fig. 2** discloses a method for isolating a network using a device having a plurality of ports constructed to transmit data received on one of the plurality of ports to other ports (**hub 14**), the plurality of ports including a first port connectable to the network (**PORT-A**) and a second port connectable to a device having functionality (**PORT-C**), the method comprising the steps of: receiving data from the network (**via PORT-A**); implementing the functionality on the device having the functionality (**via EXTENDED FUNCTIONALITY board 15**) and transmitting data from the device having functionality to at least one of the plurality of ports (e.g. via connections between **PORT-C** and **PORT-B**).

Applicant's admitted prior art fails to explicitly teach isolating the port connectable to the network from transmission of the data received on one port, and transmitting data from the device having functionality to at least one of the plurality of ports after isolating the port connectable to the network.

However, Challener et al. teaches the concept of a network isolation switch in **figure 1, element 32** capable to isolate the network transmissions between **PORT-B** and **PORT-C** of the hub **20, fig. 1 (see col. 3, lines 9-13) from the network via PORT-A**, and the concept of a service processor **24, fig. 1** that controls the switch.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify applicant's admitted prior art by placing the Challener et

al. network isolation switch inside the interface device's hub between the network and **PORT-A** of applicant's admitted prior art **fig. 2**, and by adding the service processor and attendant control lines to the board having **EXTENDED FUNCTIONALITY (15, fig. 2)**, applicant's admitted prior art. Said isolation switch would have been capable to isolate network transmissions between **PORT-C** and **PORT-B** from the network. The motivation to combine and modify is to prevent unauthorized external access to control information from the board having **EXTENDED FUNCTIONALITY (15, fig. 2)** to the client printer **10** as taught by Challener et al. in **col. 2, lines 7-11**.

Allowable Subject Matter

7. Claims 10-15 are allowed.

The following is an examiner's statement of reasons for allowance: claim 10 is allowable over the prior art or record since the cited references taken individually or in combination fail to particularly disclose setting the isolation switch to a bypass mode in which the hub does not repeat network communications to the first port; transmitting a network transmission from the circuit board to the networkable device and on a port number to which the networkable device listens; and toggling the isolation switch to the pass-through mode after the network transmission to the networkable device is complete. It is noted that the closest prior art, Challener et al. discloses a method of receiving packets addressed to the access connector attached to a particular port. However, Challener et al. fails to disclose or render obvious the above underlined limitations as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Claims 6-8, 18, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: claim 6 is allowable over the prior art or record since the cited references taken individually or in combination fail to particularly disclose an interface device wherein said circuit board listens for network transmissions at the same address as that of said networkable device. It is noted that the closest prior art, Challener et al. discloses a method of receiving packets addressed to the access connector attached to a particular port. However, Challener et al. fails to disclose or render obvious the above underlined limitations as claimed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. The following patent is cited to show the state of the art with respect to hubs used in local and wide area networks, and network systems including such secure printing:

- US-6,414,958 B1 Specht, Robert J.
- US-5,432,907 A Picazo et al.
- US-5,841,990 A Picazo et al.
- US-5,305,385 A Schanning et al.
- US-6,029,198 Iizuka, Yoshio.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jesse N. Alexander whose telephone number is (571) 272-3167. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RICKY NGO
PRIMARY EXAMINER
11/14/04